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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,699	12/29/2000	Christoph Lodde	44815/250299	9410

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

10

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-10

**Office Action Summary**

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- ☒ Responsive to communication(s) filed on 1/3/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- ☒ Claim(s) 1-17 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1, 2, 4, 6-17 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

**Application Papers**

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

**Attachment(s)**

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 2, 4 and 6-17 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More particularly, the newly presented limitation in applicant's claim preamble that the claimed tape is "free from chemical binding agents" is new matter in that it runs afoul of the rules set forth in Ex parte Grasselli et al.-Board of Appeals 231 USPQ 393, affirmed 738 F. 2d 453 (Fed. Cir. 1984) to the effect that limitations such as "free of" a certain ingredient or element are new matter in the absence of an express disclosure providing support for the limitation. The Examiner can find no such support in applicant's specification, nor has applicant pointed out any such support therefor, and the final paragraph on page 3 of the specification (which has been amended)

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fails to provide such support, either in its present condition or its former condition.

4. Claims 1, 2, 4 and 6-17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, despite the recent claim amendments, quite a few problems still appear to remain in claim 1. In claim 1, line 2 the phrase "special covering or treatment" is unduly vague and indefinite with respect to the embodiments (i.e. release sheets and/or release coatings) that are believed intended. In claim 1, line 4 of the non-marked up claim copy on page 2 of the response, the semicolon at the end of the line is clearly improper and should be removed. In claim 1, line 10 of the marked up copy the phrase "on the side opposite the adhesive coating" has no structural relationship to the claim as it exists at that point. In the next line the phrase "at a certain temperature" is believed to be vague and indefinite. In claim 1, marked up copy lines 16 and 18 the phrases "lower than said temperature of melting" and "higher than said temperature of melting" also lack proper antecedent basis. Finally, in the last two lines the phrase "selectively melted fibers" appears also to be vague, indefinite and confusing, having no structural relationship with the remainder of the claim.

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5. Claims 1, 2, 4 and 6-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Riedel et al., taken either individually, or in view of Knoke et al., substantially for the reasons set forth in paragraph No. 4 of Paper No. 7, together with the following additional observations and modifications. Applicant's amended claim preamble (which the Examiner has given weight to) recites the limitations that the tape is "free from chemical binding agents", and "can be wound . . . without use . . . special covering or treatment . . . unwound easily read for use". However, as to the first limitation, despite applicant's assertion to the contrary (Response, page 6, top paragraph) column 3, lines 59-64 teach that "interbonded by a chemical bonding agent" is only one possible alternative, and if the reference instead utilized only "physical entanglement" techniques the relied upon embodiments would read on applicant's claimed newly presented "free of . . . . binding agents" limitation in his claim preamble. In a similar vein, while column 10, lines 46-53 teach that it is desirable to use a releasable liner or a release coating, note that the disclosure does not regard such procedures as essential and also that applicant has provided no suitable comparison that would indicate his genus of articles exhibits the nonobvious properties he alleges in lines 2 and 3 of claim 1. The Examiner further notes that contrary to his earlier position Riedel et al. does indeed

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teach needle punched non-wovens, such embodiments finding support particularly at column 6, lines 57-62. Finally, contrary to applicant's assertion (Response, page 5, bottom paragraph - page 6 top paragraph) the genus of fibers disclosed in Riedel et al. particularly beginning at column 5 line 8 (e.g. column 5, lines 13-17) reads upon members of applicant's claimed genus of fibers (note the specification, page 2, paragraph 3) such that the melting points of the fibers set forth in the last seven lines of claim 1 would either be inherent, or at most obvious optimizations to one of ordinary skill, in the absence of unexpected results. With respect to the dependent claims, these are unamended, and consequently the Examiner's analysis is again believed to be substantially as previously set forth and as modified above.

6. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS

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ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc  
February 10, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300-  
1700

